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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,600	04/09/2001	Steven E. Barile	42390P9913	7945
7590	04/26/2004			EXAMINER ALAUBAIDI, HAYTHIM J
Charles A. Mirho BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP 7th Floor 12400 Wilshire Boulevard Los Angeles, CA 90025			ART UNIT 2171	PAPER NUMBER DATE MAILED: 04/26/2004 13

Please find below and/or attached an Office communication concerning this application or proceeding.

P2e

Office Action Summary	Application No.	Applicant(s)	
	09/829,600	BARILE ET AL.	
	Examiner	Art Unit	
	Haythim J. Alaubaidi	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 January 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 36-41 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 36,37,40 and 41 is/are rejected.

7) Claim(s) 38 and 39 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

1. This communication is in response to the amendment filed on January 29, 2004.
2. The Examiner acknowledges the cancellation of Claims 1-35.
3. The Examiner acknowledges the newly added Claims 36-41.
4. Claims 36-41 are currently presented for examination following the amendment, of which Claim 36 and 40 are independent.
5. Claims 36-37 and 40-41, are rejected under 35 U.S.C. 103(a).
6. Claims 38-39 are objected to as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 36 and 40, are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher Dengler (U.S. Patent No. 6,581,103 and Dengler hereinafter).

Regarding Claims 36 and 40, Dengler discloses:

generating an audio message file containing a message from the first user to the second user (Col 2, Lines 34-43)

selecting a dedication song file (Figure No 2, and corresponding text)

inserting references to the audio message file (Figure No. 3, Element No. 26) and the dedication song file (Figure No. 3, Element No. 36, i.e. song title) into the second computer user's play list (Col 3, Lines 14-24; see also Col 3, Line 66 through Col 4, Line 3; see also Col 4, Lines 24-25)

Dengler reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the first user obtaining a play list of a second user.

However, Dengler teaches a radio Internet broadcast which is acting just like the second user because the requests (dedications) are being received by this radio Internet broadcast (Col 2, Lines 54-55; see also Fig 1, Element 10; see also Col 3, Lines 37-40) also the reference teaches a live disc jockey (Col 3, Lines 4) who is reading the dedications (also known as "messages" in the current application).

Given the intended broad application of Dengler's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Dengler to include the feature of transferring a play list between two users especially when considering the disc jockey is the second user. The motivation would be to personalize the system by allowing only the receiving user (second user or the person who the dedication was sent to) to listen to the dedication on his/her computer instead of having the entire user community (everyone who is listening to the radio broadcast at the time of the dedication, {Col 2, Lines 44-47}) to listen to the

dedication; another reason, is to allow some privacy for the information being broadcast¹.

Dengler reference is also silent towards the no interaction by the second user. However the reference does teach a network that is being used to transmit the requests (Col 2, Line 44, i.e. Internet), the reference also teaches a computer application that displays a search screen (Fig 2), a search result screen (Fig 3) and a “submit” button (Fig 3, Element 32).

Given the intended broad application of Dengler’s system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant’s invention to modify the teachings of Dengler to include this process of having no interaction by the second user to apply the dedication, as its understood in the computer programming that a “submit” button in an application would normally send information (request) from one location to another (receiving entity), which can be found in Dengler’s system by the indication of the “request Queue” (Col 4, Lines 24-25) which is an indication to the fact that a request was sent to this queue, and since the communication between the entities are through the Internet, then it would have been obvious that this addition to the queue is automatic.

¹ The Examiner is interpreting In Dengler’s system two entities: entity one is the user (also referred to as the “listener” who is requesting the song or the video to send or dedicate it to the second entity; and entity two is the receiving part which can be a user or a computer (Col 2, Lines 44-47) or a live disc jockey (Col 3, Lines 4)

Dengler reference is silent towards the insertion point. However the reference does teach when a request (dedication) will be played and how it effect the sequence of the play lit if there is a request and if there is no request (Col 3, Lines 14-24), the reference also teaches a notification to the requester regarding if any requests are ahead, and if there are then how many requests are ahead of it (Col 3, Line 66 through Col 4, Line 3); the reference also teaches sending an e-mail² with the associated dedication to the destination user (Col 3, Lines 9-10).

Given the intended broad application of Dengler's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Dengler by allowing the requester to indicate an insertion point for the dedication in the listeners play list, a good reason to modify the reference would be to increase the flexibility of the system, thus by allowing the requester to decide the insertion point instead of having the system to decide (Col 3, Lines 14-24; see also Col 3, Line 66 through Col 4, Line 3), increasing the flexibility would also lead to increase in the amount of users who would like to use, own or purchase the system, for example, a user would like to hear his/her request played at a certain time because he/she knows what time the other user (listener) would be available to listen to the request.

9. Claims 36 and 40, are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher Dengler (U.S. Patent No. 6,581,103 and Dengler hereinafter) in view of Harry W. Morris (U.S. Patent No. 6,496,851 and Morris hereinafter).

² In regard to the insertion point; the e-mail mentioned in Dengler could be interpreted to do so. As part of

Regarding Claims 37 and 41, Dengler reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate communicating or sending the play list to another user only when the other user is online. Morris however discloses communicating or sending the play list to another user only when the other user is online, as this is a main feature of the so called Chat Rooms; both users must be logged on to the system or the community to actually communicate or send a text, audio or even video file to each other. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Dengler with the teachings of Morris in order to minimize the use of system resources by not sending or receiving any requests if the second user is not online.

Allowable Subject Matter

10. Claims 38-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is the Examiner's statement of reasons for the indication of allowable subject matter:

Regarding Claim 38, Applicant's particular method for dedicating a song file from one user to another is the feature of automatically processing the play list by the media

the functionality of e-mail is scheduling an outgoing e-mail; in other words user A can schedule the

player application and rendering the audio message file and the and the dedication song file for perception by the second computer user without interaction by the second computer user in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record or that encountered in searching of the prior art.

The dependent Claim 39 being further limiting to dependent Claim 38, definite and enabled by the Specification would also be allowed if their respective dependent Claim 38 is rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments with respect to claims 36 and 40 have been fully considered but are moot in view of the new ground(s) of rejection.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points of Contact

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

Patent Examiner
Technology Center 2100
April 17, 2004



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100